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ATTORNEY DOCKET NO. 16018RRUS03U (NORT10-00453)
U.S. SERIAL NO. 10/814,359
PATENT

REMARKS

Claims 1-3 and 5-20 are pending in the application.

Claims 1-3 and 5-20 have been rejected.

Claims 1, 9, 12, 16 and 19 have been amended, as set forth herein, to correct spelling.

I. REJECTION UNDER 35 U.S.C. § 103

Claims 1-3 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Patent Application 2002/0065864) in view of Alperovich (US Patent 6,175,741). Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Patent Application 2002/0065864) in view of Alperovich (US Patent 6,175,741), and further in view of Aschir (US Patent Application 2002/0071444). Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Pat App 2002/0065864) in view of Alperovich (US Patent 6,175,741), and further in view of Hitzeman (US Pat App 2003/0220115). Claims 8, 11, 14-15 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Pat App 2002/0065864) in view of Haumont, et al. (US 6,955,918), and further in view of Alperovich (US Patent 6,175,741). Claims 9, 12, 16 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Pat App 2002/0065864) in view of Haumont, et al. (US 6,955,918), and further in view of Alperovich (US Patent 6,175,741), and further in view of Aschir (US Pat App 2002/0071444). Claims 10, 13, 17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartsell, et al. (US Pat App 2002/0065864) in view of Haumont, et al. (US

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6,955,918), and further in view of Alperovich (US Patent 6,175,741), and further in view of Hitzeman (US Pat App 2003/0220115). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

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expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

The primary reference for all of the stated 103 rejections is Hartsell, while it appears that the two main references upon which the rejections of independent Claims 1, 8 and 15 are based are the Hartsell and Alperovich references.

Hartsell describes a method and system for providing differentiated service and management to deliver content or services in a network computing system. Hartsell, Abstract; paragraphs 0002-0003. This basic computing system (or content delivery system) is generally described with reference to Figure 1A. Though Hartsell's computing system 1010 may be connected to a wireless network (see, paragraph 0051), this is about the only similarity that can be found with respect to the Applicant's subject matter describing wireless priority services within a wireless network and a mechanism (i.e. code) for identifying that a mobile switching center (MSC) supports certain wireless priority services for roaming wireless subscribers. In fact, Hartsell does not appear to address or even relate substantively to wireless communications networks and the roaming of a mobile subscriber between different wireless networks (or MSC areas) having different/same wireless subscriber priority services schemes.

While Hartsell broadly describes class of service on per-class, per-connection or per-subscriber basis (paragraph 0289), the class of service associated with the communicating device is

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usually identified by the service level agreement (SLA). Hartsell's computing system appears to determine a particular class of service to which the communicating device is entitled (from certain knowledge or operating characteristics) and provides that particular level of service. As a result, Hartsell's computing system simply operates to provide the class of service to the communicating device. Thus, there is no indication or reasoning in Hartsell for determining or identifying what class of service the computing network is capable of handling, or identifying what priority service the computing network supports.

As noted above, Applicant respectfully submits that Hartsell is not within the same field of endeavor as the Applicant's claimed invention, and even if considered to fall within the relevant prior art, Hartsell's teachings are limited -- limited to simply providing different classes of services for devices within a computing network.

Similarly, Alperovich's business card services application, though performed within a wireless network, does not appear directed to, depend upon, or discuss, identifying the priority service capabilities of a mobile switching center (MSC). Business card information stored within a mobile subscriber (MS) is transmitted (using a business card software application in the MS) to another MS. When information is updated in the first MS, the updated information is automatically transmitted to the other MS for updating also. Alperovich, Abstract.

While Alperovich teaches that the business card application can be further enhanced to provide supplemental services, such as call forwarding, call blocking, caller ID, call forwarding, call priority, positioning and multiparty calling (see, Col. 5, lines 40-44), none of these services relate

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to priority capability services information defining the priority services supported by an MSC, as described in Applicant's specification. The "call priority" supplemental service merely identifies whether an incoming telephone number matches a stored telephone number marked with a priority. If so, the MS sends a call priority request/command to the wireless network, and if the network experiences difficulties, the call will not be preempted and will be allowed to continue (i.e., priority). See, Col. 8, lines 15-38. Therefore, the wireless network simply operates in a priority mode for that call.

Neither Alperovich's "call priority" supplemental service or other supplemental services are related to determining the wireless priority services supported by a particular MSC. Alperovich simply provides the specific priority service available in the wireless network when requested. Thus, there does not appear to be any reason or description about identifying the priority services capability of the MSC (or wireless network in which the MS is located). In distinct contrast, for roaming mobile subscribers, Applicant's specification describes that it is beneficial for the MSC to identify its priority services capabilities to the HLR - since different priority services schemes may exist.

As noted above, Applicant respectfully submits that (1) the Office Action interpretations of the Hartsell and Alperovich references are overly broad, (2) the two references are not directed to the utilization of priority services capability information (in a code) to define the priority services supported by an MSC, (3) the Hartsell reference is directed to a computing network, with little relevance to a wireless network and MSC capabilities, and (4) the Alperovich is directed mainly to a business card application for transferring data between two MSC. As a result, the combination of

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these two references is not well-taken. Even if combined, the combination fails to teach, suggest or disclose Applicant's claimed invention as set forth in independent Claims 1, 8 and 15 (and their dependent claims). Furthermore, none of the other secondary references appear to cure the deficiencies in the Hartsell and Alperovich references.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 1-3 and 5-20.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

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If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@munckbutrus.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

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